

REMARKS / ARGUMENTS

Introduction

The present Amendment is in response to the Examiner's Office Action mailed August 24, 2004. Claims 1, 5-8, 11, 14-15, 18, and 22-23 are amended. Claims 1-25 remain pending in the application.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Information Disclosure Statement

Applicants thank Examiner for considering the documents submitted in the Information Disclosure Statement submitted on July 19, 2004.

Drawings

The Examiner objects to Figure 5B on the grounds that the figure does not include a legend designating it as "Prior Art." As indicated in the "Amendments to the Drawings" section, Applicants submit a new Figure 5B which the "Prior Art" legend. Also enclosed is a redlined copy of Figure 5B showing the change being made.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 5, 6, 9, 11, 16, 18, and 24 were rejected under 35 U.S.C. § 102(e)¹ as being anticipated by U.S. Patent No. 6,554,492 (Gilliland). Anticipation, as discussed in M.P.E.P. § 2131, requires that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987). The following discussion illustrates that Gilliland does not satisfy the requirements of *Verdegaal*.

Regarding claims 1, 5, 6, 9, 11, 16, 18, and 24, the Office Action suggested that these claims include functional limitations. Relying on MPEP § 2114, the Office Action suggested, regarding the functional limitations, that “a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.”

However, MPEP § 2173.05(g) states that “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” In fact, there is ample precedent to establish that functional limitations are appropriate in claims and should be afforded patentable weight by the Examiner for determining anticipation. *See In Re Land*, 368 F.2d 866, 151 USPQ 621 (C.C.P.A. 1966). The CCPA further states that “there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical necessity for the use of functional language.” *See In re Swinehart*, 439 F.2d 210 (C.C.P.A. 1971).

Section 2112.01 of the MPEP, which discusses situations when the structure recited in the reference is substantially identical to that of the claims, teaches that a *prima facie* case of anticipation can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In this case, the Office Action admits that Gilliland does not disclose or suggest a second transmitter and a second receiver. As a result, Gilliland also fails to disclose a plurality of pads that “are selectively operable to communicate with a second receiver and a second transmitter”, as required by claim 1.

¹ Because *Gilliland* is only citable under 35 U.S.C. § 102(e), Applicants do not admit that *Gilliland* is prior art to the claimed invention, but reserve the right to swear behind *Gilliland* if necessary to remove it as a reference.

Nonetheless, claim 1 has been amended to require first transmitter pads, first receiver pads, second transmitter pads, and second receiver pads. In claim 1, the requirements of first transmitter pads and first receiver pads provide additional structure to the first plurality of pads that are used to communicate with a first receiver and a first transmitter of the optoelectronic transceiver module. The second transmitter pads and the second receiver pads provide additional structure that enable the third plurality of pads to communicate with a second transmitter and a second receiver.

As noted in the Office Action, regarding claims 7, 8, 14, 15, 22, and 23, the Examiner admits that Gilliland fails to disclose or suggest a second transmitter and a second receiver of the optoelectronic receiver. It follows that Gilliland also fails to disclose or suggest second transmitter pads and second receiver pads that can communicate with a second transmitter and a second receiver. As a result, claim 1 is believed to overcome the art of record and is in condition for allowance. For similar reasons, claims 11 and 18 also overcome the art of record and are in condition for allowance. The dependent claims 5, 6, 9, 16, and 24 are also believed to be in condition for allowance.

Allowed Subject Matter

Applicant appreciates the acknowledgement of the Examiner that claims 2-4, 7, 8, 10, 12-15, 17, 19-23, and 25 would be allowable if rewritten in independent form. In view of the amendments and remarks herein, Applicants believe that claims 1, 11 and 18 are in condition for allowance. As a result, the dependent claims 2-4, 7, 8, 10, 12-15, 17, 19-23, and 25 are also in condition for allowance.

Conclusion

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 24th day of January 2005.

Respectfully submitted,



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AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Figure 5B. This sheet, which includes Figures 5A and 5B, replaces the original sheet including Figures 5A and 5B. In Figure 5B, the "Prior Art" legend has been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes